No. 73-833

15 1974

MICHAEL RODAK, JR., CL

In the Supreme Court of the United States

OCTOBER TERM, 1973

HAROLD W. DOYLE, PETITIONER

v.

COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

ROBERT H. BORK,
Solicitor General,
Department of Justice,
Washington, D.C. 20530.

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Petitioner seeks review of a decision of the Court of Customs and Patent Appeals which upheld the denial of his application for reissue of a patent.

1. On July 2, 1968, petitioner was granted a patent on a method for grading clothing patterns. In 1970, petitioner applied to the Patent Office for reissue of the patent pursuant to 35 U.S.C. 251, which permits a new patent to be issued for the unexpired term of an existing patent for the purpose of correcting errors that made the original patent defective.[1]

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[1] 35 U.S.C. 251 provides:

> Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification

That statute provides that the standards applicable to original patent applications are applicable to applications for reissue. 35 U.S.C. 112, governing original applications, requires that all patent applications contain a specification consisting of both a written description of the invention and instructions for the construction and use of the invention "in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains * * * to make and use" the invention.[2]

After filing his application for reissue of the patent, petitioner was informed by the Patent Office

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or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

* * * * *

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

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[2] 35 U.S.C. 112 provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

* * * * *

Examiner that the application did not comply with 35 U.S.C. 112 because it did not contain adequate instructions for making and using the invention. Petitioner attempted to correct this deficiency by submitting evidence that purported to demonstrate that persons "skilled in the art" could construct petitioner's invention by following the instructions filed with the application.The Patent Office Examiner rejected petitioner's application, holding that petitioner's evidence, which consisted of affidavits and excerpts from depostitions, did not satisfactorily demonstrate that persons skilled in the art could construct petitioner's invention simply by following the directions filed with petitioner's application. The Patent Office Board of Appeals upheld that ruling, and the Court of Customs and Patent Appeals affirmed (482 F. 2d 1385).

2. The dispositive issue in this case is the sufficiency of the evidence. When the Patent Examiner challenged the adequacy of petitioner's specification, the burden was on petitioner to present sufficient evidence to rebut that challenge. *In re Ghiron*, 442 F. 2d 985 (C.C.P.A.). Petitioner's evidence was found to be insufficient to carry this burden. 482 F. 2d at 1389, 1391-1392. This factual ruling does not warrant further review.

Petitioner also contends that because the disclosure in his application for reissue of the patent is essentially identical to that submitted with the original patent application, which was granted, the doctrine of *res judicata* bars rejection of the application for reissue. An application for reissue of a patent, pursuant to 35 U.S.C. 251, seeks to correct errors in the original application that rendered the patent defective. A prior

grant of a patent by a Patent Office Examiner that turns out to have been defective does not bind another Examiner who is requested to correct the error on the basis of new information. *In re Riddle*, 438 F. 2d 618 (C.C.P.A.); *Fessenden* v. *Coe*, 99 F. 2d 426 (C.A.D.C.).

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

ROBERT H. BORK,
Solicitor General.

MARCH 1974.

[OCR 1974-03]